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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,011	08/22/2003	Heinz-Peter Klein	RUH-330	1455

7590 07/16/2004

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EXAMINER
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CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/647,011	<b>Applicant(s)</b> KLEIN ET AL.	
	<b>Examiner</b> William K Cheung	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1218</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a dispersion powder composition, classified in class 526, subclass 78.
  - II. Claims 15-20, drawn to a process for preparing a dispersion powder composition, classified in class 526, subclass 292.2.
  - III. Claims 21, drawn to process of hydrophobicizing mortar or concrete, classified in class 210, subclass 734.

2. The inventions are distinct, each from the other because:

Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as an emulsion polymerization process.

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3. Inventions Group I and Group III are independent of each other. The invention of Group I is drawn to a dispersion powder composition while the invention of Group II is drawn to a process of hydrophobicizing mortar or concrete.

4. Inventions Group II and Group III are independent of each other. The invention of Group II is drawn to a process for making a dispersion powder composition while the invention of Group II is drawn to a process of hydrophobicizing mortar or concrete.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Charles A. Muserlian (Registration # 19,683) on July 11, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/398095. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application is the genus invention of the invention of copending Application No. 10/398095.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-5, 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Satomi et al. (US 4,734,135).

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*The invention of claims 1-5, 7-10 relates to a **dispersion powder composition**, based on **water-insoluble polymers** and comprising, based on the total weight of the polymer, an amount in the range from **0.1 to 30% by weight of at least one carboxylic ester** whose **acid component has at least 6 carbon atoms** and whose **alcohol component is a polyhydroxyl compound**.*

Satomi et al. (abstract ; col. 5, line 26-35; col. 6, line 1-17, 40-56; col. 7, Example 1; col. 9-10, claim 1) disclose a composition comprising the ingredients such as a composition comprising at least one carboxylic esters as claimed. In view of the substantially identical composition, the examiner has a reasonable basis to believe that the claimed "water insoluble polymer" feature is inherently possessed in Satomi et al. Satomi et al. contain all the limitations of claims 1-5, 7-10. Therefore, it would not be difficult for one of ordinary skill in art to obtain the invention of claims 1-5, 7-10 after reading the disclosure to Satomi et al. Claims 1-5, 7-10 are anticipated. Regarding the claimed "polyvinyl alcohol with degree of polymerization of 200 to 3500 and a degree of hydrolysis of from 80 to 98 mol% is used as protective colloid" of claim 8, the examiner believes that disclosure of Satomi et al. inherently possessed the claimed feature because the claimed scope is broad enough to encompass most of the commercially available polyvinyl alcohol.

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12. Claims 1-5, 7-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chiou et al. (US 5,606,015).

*The invention of claims 1-5, 7-10 relates to a **dispersion powder composition** and a process for making the same, based on **water-insoluble polymers** and comprising, based on the total weight of the polymer, an amount in the range from **0.1 to 30% by weight of at least one carboxylic ester** whose **acid component has at least 6 carbon atoms** and whose **alcohol component is a polyhydroxyl compound**.*

Chiou et al. (col. 1, line 13-21) disclose a spray-dried emulsion polymers comprising polymer powder for cement applications. Further, Chiou et al. (col. 1, line 52-67) disclose said composition comprising a carboxylic ester. Chiou et al. (Claims 1, 4, 5) clearly disclose the amount of carboxylic ester as claimed. Chiou et al. contain all the limitations of claims 1-5, 7-10. Therefore, it would not be difficult for one of ordinary skill in art to obtain the invention of claims 1-5, 7-10 after reading the disclosure to Chiou et al. Claims 1-5, 7-10 are anticipated. Regarding the claimed "polyvinyl alcohol with degree of polymerization of 200 to 3500 and a degree of hydrolysis of from 80 to 98 mol% is used as protective colloid" of claim 8, the examiner believes that disclosure of Chiou et al. inherently possessed the claimed feature because the claimed scope is broad enough to encompass most of the commercially available polyvinyl alcohol.



***Allowable Subject Matter***

13. Claims 6, 11-14 would be allowable if the ODP rejection set forth in instant office action is overcome.

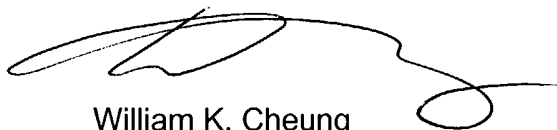
***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'William K. Cheung', with a large, stylized loop at the end.

William K. Cheung

Primary Examiner

July 14, 2004